

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 1-3 and 5-8 have been amended. Claim 29 has been added. Also, claims 4 and 9-28 have been canceled herein, and claim 26 was previously canceled, without prejudice of disclaimer of the subject matter contained therein. Thus, claims 1-3, 5-8 and 29 are pending in the present application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, support for the amendment to claim 1 is found in canceled claims 27-28 as well as in the specification at page 38, lines 8-13.

No new matter has been added with new claim 29, wherein support is found in at least claim 1.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-4, 9 and 11-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tetsuo *et al.* '234 (European Patent Application No. EP 1065234 A2 (2001)) (see pages 2-6 of the Office Action).

Also, claims 5, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tetsuo *et al.* '234 (see pages 6-8 of the Office Action).

Further, claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tetsuo *et al.* '234 further in view of Nishizawa *et al.* '564 (U.S. Patent Application Publication No. 2006/0123564 A1) (see pages 8-11 of the Office Action).

In addition, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tetsuo *et al.* '234 in view of Nishizawa *et al.* '564 further in view of Nakazato *et al.* '942 (U.S. Patent No. 6,290,942) (see pages 11-12 of the Office Action).

Regarding the § 102(b) rejection in view of Tetsuo *et al.* '234, Applicants respectfully refer the Examiner to claim 1 as presented herein. Claim 1 incorporates subject matter from claims 27-28, which are not at issue here. Thus, this rejection has been instantly overcome.

Regarding the other three § 103(a) rejections, wherein all rejections cite Tetsuo *et al.* '234 alone or in combination, Applicants respectfully traverse and request reconsideration based on the following remarks.

The Examiner states on page 8 of the Office Action that it would have been obvious to one of ordinary skill in the art to use the composition taught by Tetsuo '234 in a hair dressing application, such as hair treatment, because the composition has excellent storage stability in an

emulsified condition. Applicants respectfully traverse this statement since such storage stability as asserted by the Examiner is not found or taught in the cited primary reference.

The invention disclosed in Tetsuo '234 relates to a silicone for powder treatment (see its claim 1 at pages 22-23) and a cosmetic comprising powder surface-treated with the silicone (see claims 8-19 at page 23). The storage stability in an emulsified condition cited by the Examiner (in the Office Action, the Examiner refers to page 2, paragraph [0009]) means storage stability of a emulsified cosmetic containing powder surface-treated with the silicone, as described at page 22, paragraph [0138] of the cited primary reference. Thus, this part of Tetsuo '234 describing storage stability is not with respect to the instantly claimed composition. Instead, Tetsuo '234 states its composition is stable for, e.g., an emulsified cosmetic containing powder surface-treated with the silicone. Thus, Applicants respectfully traverse in that the requisite motivation¹ is not found based upon a reading of the cited Tetsuo '234 reference. *See* M.P.E.P. § 2143.

Also in Tetsuo '234, the surface-treatment is performed by:

- i) adding the silicone diluted with toluene to powder,
- ii) heating the powder to distill off the toluene, and
- iii) stirring the powder at 150 °C for 3 hours "to effect the baking treatment" (see page 12, paragraph [0091]).

In other words, the baking causes the silicone to form a linkage with the powder surface, leading to a structural change of the silicone. Tetsuo '234 describes a different silicone composition, and thus does not teach storage stability of the silicone by itself but instead a baked

¹ The teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. *See KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385, 1395 (U.S. 2007).

formed of silicone. Thus, the requisite reasonable expectation of success is lacking since, e.g., the claimed combination cannot change the principle of operation of the primary reference (e.g., Tetsuo '234) or render the reference inoperable for its intended purpose. *See* M.P.E.P. §§ 2143.01(see sections entitled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory For Its Intended Purpose" and "The Proposed Modification Cannot Change the Principle of Operation of a Reference") and M.P.E.P. § 2145(III).

Further, adding the disclosures of Nishizawa *et al.* '564 and/or Nakazatoa *et al.* '942 does not correct the problems associated with the primary reference. Tetsuo '234 would still require silicone for powder treatment, with baking, and which is even claimed as seen on pages 22-23 thereof. Thus, these rejections under § 103(a) are improper.

Even if the silicone of Tetsuo '234 exists on the powder surface in its original, chemical form, the storage stability attained by baking at 150 °C for 3 hours does not provide the requisite motivation for one of ordinary skilled in the art to use the silicone for conditioning hair, because such baking cannot be applied to the hair. In other words, such application of Tetsuo '234 in attempt to achieve what is instantly claimed would not work. Accordingly, the asserted motivation related to storage stability is improper, and does not apply to the present invention. Further, the conditioning effect attained by applying the presently claimed composition is not found in the disclosure of Tetsuo '234.

Thus, Applicants respectfully submit that Tetsuo '234 is not properly cited and that these rejections are improper.

Based on the above, reconsideration and withdrawal of the § 102(b) and § 103(a) rejections are respectfully requested.

Conclusion

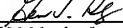
In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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